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EXAMINER

AVELLINO, JOSEPH E

ART UNIT	PAPER NUMBER
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2143

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09/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/608,230

Applicant(s)

SAR-SHALOM, YARON

Examiner

Joseph E. Avellino

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on September 6, 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-52 are presented for examination; claims 1, 22, 32, 46 and 51 independent.

Claim Rejections - 35 USC § 101

2. The Office has considered the amendments to the claims. The rejection under 35 USC 101 is hereby withdrawn.

Claim Rejections - 35 USC § 112

3. The Office has considered the amendments to the claims. The rejection under 35 USC 112, second paragraph is hereby withdrawn.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-6, 19, 21-28, 30-42, 44, and 46-52 are rejected under 35 U.S.C. 102(e) as being unpatentable over Dhara et al. (US 2004/0005042) (hereinafter Dhara).

4. Referring to claim 1, Dhara discloses an automatic messaging client launcher for a communication device (i.e. called party) for automatically launching a messaging

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client (i.e. send an instant message) of an originating device (i.e. calling party cellular telephony device 106), said launcher comprising:

an availability detector (i.e. calling party dialog instance 130, 132), for detecting availability of said destination device (i.e. gets status of the telephony device) (Figure 2; ¶ 32); and

a messaging initiator associated with said availability detector for launching said messaging client (the Office construes the phrase “launching the messaging client” as sending a message to the client to display a pop-up window on the client device), when said destination is unavailable (i.e. called party dialog 132 may send an instant message to calling party device 102 to indicate the called party’s busy status) (Figure 2; ¶ 23).

5. Referring to claim 2, Dhara discloses the communication device comprises a telephony device (¶ 23).

6. Referring to claim 3, Dhara discloses providing destination device addressing information to said messaging client (i.e. the “instructions” are forwarded to the calling party telephony device, which then transmits the instructions 210 to the calling party dialog, and then to the called party dialog 222, therefore there inherently must be some destination information provided to the calling party in order to correctly forward the instructions back to the called party dialog) (Figure 2).

7. Referring to claim 4, Dhara discloses launching the messaging client by inputting a message to said messaging client (i.e. transmitting an instant message to the telephony device to solicit instructions) (Figure 2; ¶ 23).

8. Referring to claim 5, Dhara discloses that the reply to said message is addressed to said destination device (i.e. a request for information is transmitted from said called party to the calling party to solicit information, which is then replied and eventually forwarded back to the called party device) (Figure 3, ref. 326, 328).

9. Referring to claim 6, Dhara discloses providing destination device addressing information in a reply field of said message (i.e. set up two-way communications path to the calling party to establish communications path to accept call) (Figure 3; ref. 330; ¶ 39-40).

10. Referring to claim 19, Dhara discloses the system detects unavailability by reading a busy signal from the destination device (Figure 2, ref. 212).

11. Referring to claim 21, Dhara discloses the system will send a message which appears to be sent from said destination device (i.e. in order to solicit information for the disposition of the call, the called party dialog will ask questions such as “what is the nature of the call”, “what is the calling party’s name”, etc. In this sense it appears that it

is the destination device which asks these questions, or a representative thereof)
(Figure 2).

12. Claims 22-28, 30-42, 44, and 46-52 are rejected for similar reasons as stated above.

Claim Rejections - 35 USC § 103

13. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 7-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dhara.

14. Referring to claim 7, Dhara disclose the invention substantively as described in claim 3, however does not specifically disclose the messaging client comprises an integrated component of said launcher, however it has been held obvious to make things integral. See *In re Larson* 144 USPQ 347 (CCPA 1965). By this rationale, one of ordinary skill in the art would find it obvious to combine a component of the launcher with the messaging client, thereby provided an integrated program which improves communications and reliability.

15. Referring to claim 8, Dhara discloses that the messaging client is operable to send a message to said destination device (Figure 3, ref. 324, "transmit information" is sent from the calling party to the called party).

16. Referring to claim 9, Dhara discloses the messaging client is operable to send said message upon a user command (i.e. the calling party transmits the information regarding the disposition of the call) (Figure 3; ¶ 36-39).

17. Referring to claim 10, it is inherent that the destination device is provided in a destination field, since the destination device is the recipient of the "information" provided by the calling party (¶ 36-39).

18. Referring to claim 11, Dhara discloses the messaging client is operable to display a message content input screen on said originating communication device (i.e. the request for information or request for instruction messages are displayed on the calling device) (Figures 2-3).

19. Referring to claim 12, Dhara discloses the type of message can include voice message (i.e. text to speech) (¶ 37).

20. Referring to claim 13, Dhara discloses the message includes text (i.e. it is inherent that the instant message includes text) (¶ 26).

21. Referring to claim 14, Dhara discloses the content includes default message content (i.e. if the called party is busy then a default script based on the user selected script is shown as to how to dispose of the call) (Figure 2, ref. 218; ¶ 33-34).

22. Referring to claim 15, Dhara discloses the invention substantively as described in claim 14. Dhara does not specifically disclose automatically sending the default message from the calling party to the called party, however automatic instant messaging systems are well known in the art. By this rationale, "Official Notice" is taken that both the concepts and advantages of providing for automatic message senders is well known and expected in the art. It would have been obvious to one of ordinary skill in the art to modify the system of Dhara in order to provide an automatic disposition of the call based on previously established guidelines.

23. Referring to claim 16, Dhara discloses the invention substantively as described in claim 14. Dhara does not specifically disclose the default message is specified by the originating communication device, however the calling party does have the ability to determine the instruction on how to finish the call (i.e. leave a voicemail, instant message, email, etc.), thereby allowing the calling party some flexibility in how to use the system. Furthermore, user-selected messages are well known in the art (i.e. user configured systems). By this rationale, "Official Notice" is taken that both the concepts and advantages of providing for having the user select the default message is well

known and expected in the art. It would have been obvious to one of ordinary skill in the art to modify the teaching of Dhara in order to allow the user to select the default message in order to customize the system to the users liking, and further can allow the use of multiple languages without the trouble of learning those languages (i.e. if an English user wished to reach a Spanish user, yet the user would be unable to understand the "instructions" if they were in Spanish.

24. Referring to claim 17, Dhara discloses the client launcher is activated and deactivated by said originating communication device (i.e. the launcher only works when the calling party actually calls a destination device, therefore the system is event-driven and will only work based on the originating device's wishes) (Figure 2).

25. Referring to claims 18 and 20, Dhara discloses the invention substantively as described in claim 1, however do not specifically disclose that the system is able to detect unavailability based on a number of rings or being sent to voicemail, however these are standard triggering signals which could be easily used instead of the "busy" status signal as is used in Dhara. By this rationale, "Official Notice" is taken that both the concept and advantages of providing for using a set number of rings or being sent to voicemail to detect unavailability is well known and expected in the art. It would have been obvious to one of ordinary skill in the art to modify the system to utilize a set number of rings or sent to voicemail to detect unavailability in order to customize the

system to the user's liking, thereby providing a customized and tailored system to the user.

26. Claims 29, 43, and 45 are rejected for similar reasons as stated above.

Response to Arguments

27. Applicant's arguments filed May 23, 2007 have been fully considered but they are not persuasive.

28. In the remarks, Applicant argues, in substance, that (1) Dhara does not disclose launching a messaging client in order to conveniently leave a message for the called party, (2) Dhara only describes the use of one of the six communication devices described in claim 2, (3) the "instructions" sent in Dhara do not correspond to addressing information, and therefore is not inherent to the system of Dhara, (4) Dhara does not disclose inputting a message to the messaging client so that the calling party can create and send a message back to the unavailable called party, (5) it would not be obvious to provide an integral program of the client launcher as discussed in claim 7, (6) Dhara does not disclose default message content.

29. As to point (1), it is noted that the features upon which applicant relies (i.e., messaging client in order to conveniently send a message to the unavailable device) are not recited in the rejected claim(s). Although the claims are interpreted in light of

the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claim merely recites that a messaging client is opened when the destination device is unavailable. Since an instant message is sent to the calling party indicating that the user is busy, this clearly meets the claimed "launching a messaging client". By this rationale, the rejection is maintained.

30. As to point (2), the claim reads one *of a group*. In order to meet the claim limitations, only one of the group must be disclosed in the invention. As such, since Dhara discloses the use of a telephony device (see rejection above), then Dharia meets the claimed limitation. By this rationale, the rejection is maintained.

31. As to point (3), Applicant is incorrect in the interpretation of the reference. Applicant is invited to review any reference which discusses instant messaging protocols and that in order for a message to reach its destination, it **MUST** include some sort of addressing information (i.e. an IP address, a username, etc.). If there was no destination information supplied with the instruction message of Dhara, then the message would never reach its intended destination, since any intermediate networks would not know how to route this particular message. This is an inherent feature for any message on a network. By this rationale, the rejection is maintained.

32. As to point (4), Applicant is, once again, importing limitations from the specification into the claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claim plainly reads that a message is inputted to the messaging client. No mention of any destination or that the message is even sent to any entity. Since the user sends "instructions" to the called party interface with respect to the disposition of the call, this clearly meets the claimed limitation. By this rationale, the rejection is maintained.

33. As to point (5), Applicant is incorrect. One of ordinary skill in the art would have the necessary technical expertise in order to provide a computer program into the messaging client launcher system. Appellant further argues that this integration would require specific knowledge of the type of network used, the type of device used, as well as the protocols and capabilities of the messaging client and the messaging client launcher, however all of this knowledge are well known published standards which can be referenced and understood by one of ordinary skill in the art to generate various computer programs to execute on the network and devices in question. There would be no issue with compatibility and this does not render the claim nonobvious. By this rationale, the rejection is maintained.

34. As to point (6), Applicant is incorrect. The predefined scripts define what is to be said to the calling party. If the script is predefined, then the text which is provided in the

instant message is also predefined, hence is considered a default text. By this rationale, the rejection is maintained.

Conclusion

35. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

36. Applicant has failed to seasonably challenge the Examiner's assertions of well known subject matter in the previous Office action(s) pursuant to the requirements set forth under MPEP §2144.03. A "seasonable challenge" is an explicit demand for evidence set forth by Applicant in the next response. Accordingly, the claim limitations the Examiner considered as "well known" in the first Office action, are now established as admitted prior art of record for the course of the prosecution. See *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'J. Avellino', with a stylized flourish at the end.

Joseph E. Avellino, Examiner
September 15, 2007